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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,589	10/20/1998	ANDREA M. JACOBSON	12369.SUS01	7081

23552 7590 11/30/2004

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/175,589

Applicant(s)

JACOBSON, ANDREA M.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 are pending in this communication filed 6/09/04 as Amendment and Extension of Time and 09/09/04 as RCE. Claims 1, 13, 17, and 20 have been amended and claim 23 has been added.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/09/04 has been entered.

Claim Rejections - 35 USC § 112

- 3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 6 reads "the pre-determined network security policy". It is very vague and unclear in the claim language what Applicant means by "pre-determined network security policy". Does applicant mean "network security" rules or requirements or user rights?

Line 8 reads "sending the electronic record to a recipient; and". It is unclear and cannot be determined where the electronic record is being sent from to the recipient. Is

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the electronic record being sent from the network or from another user and who or what is automatically denying a request to delete the electronic record before expiration ..."?

Claim 5, reads "... comprises a computer having a registry and a user profile, wherein creating the electronic tag comprises generating a reference code, wherein the electronic tag is generated at least in part as a function of at least one of the registry, the user profile, and the reference code." This claim limitation is confusing as written. The Examiner is unable to determine what Applicant is trying to say or to claim. There appears to be some wording missing in the claim limitation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over "http://www.ustrim.com/trim/page 31.htm", hereafter ustrim in view of (US 6,108,688) Nielsen.

With respect to claim 1, USTrim teaches, creating an electronic tag that uniquely identifies the electronic record, the electronic tag being associated with a specified time period for compliance with the pre-determined network security policy (see "publishing records on the WWW" page 1 and "Security and Privacy of Records" page 2); storing the at least one electronic tag in a central repository (see "Record Navigation" page 1, "WWW Access to TRIM DataBases" page 1, and "Publishing Records on the WWW" page 1).

Ustrim failed to teach, sending the electronic record to a recipient. Nielsen teaches, sending the electronic record to a recipient (col. 2, lines 57-66). It would have been obvious to one having ordinary skill in the art at the time the invention was made to send the electronic record to a recipient and to modify in Ustrim in view of Ustrim's teachings of an electronic tag and electronic documents and because such a modification would allow Ustrim to be addressed to a recipient and to arrive at the recipient's computer terminal with minimal information about the message.

Ustrim teaches, automatically denying a request to delete the electronic record before expiration of the specified time period associated with the electronic tag (page 1, "Retention & Disposal of Records" (also see fig. of screen shot). Ustrim did not expressly disclose automatically denying a request to delete the electronic record before expiration of the specific time period. However, Ustrim shows in a figure of the screen shot of a 2 year archive and destroying after 6 years. Nielsen teaches, a date and time in fig. 2. It is well known in the art of electronic mail and network security that electronic mail documents are either deleted, purged, archived or destroyed after a period of time.

7. Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ustrim and Nielsen in view of (EP 0346556) Mourier.

With respect to claim 2, Ustrim and Nielsen failed to teach, further comprising deleting the electronic record and selectively deleting the at least one electronic tag.

Mourier teaches, further comprising deleting the electronic record and selectively deleting the at least one electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to delete the electronic record and selectively delete the at least one electronic tag and to modify in UStrim because such a modification would allow UStrim to have the tag transferred into the "To Be Answered" file and deleted from the "To Be Assigned" file (purging the electronic record comprising the steps of deleting the electronic record).

With respect to claim 3, UStrim teaches, further comprising storing the electronic record ("WWW Access to Trim DataBase" page 1).

With respect to claim 4, Ustrim teaches, determining whether the request is consistent with the network security policy ("Security and Privacy of Records" page 1).

With respect to claim 5, Ustrim and Nielsen failed to teach, wherein the electronic tag is generated at least in part as a function of at least one of the registry, the user profile, and the reference code. Mourier teaches, wherein the electronic tag is generated at least in part as a function of at least one of the registry, the user profile, and the reference code (col. 4, lines 12-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the electronic tag generated at least in part as a function of at least one of the registry, the user profile, and a reference code and to combine Ustrim's electronic tag that uniquely identifies the electronic record with Mourier's network user's user profile, reference code, and electronic tag being generated at least in part as a function of at least one of the registry, the user profile, and the reference code because such a combination would

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allow Ustrim to manage electronic mail without wasteful memory space and without having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, UStrim and Nielsen failed to teach, generating the reference code comprises reading the electronic record. Mourier teaches, generating the reference code comprises reading the electronic record (page 7, lines 16-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate the reference code comprising reading the electronic record and to modify in UStrim because such a modification would allow Nielsen to have a special memory section within his machine, memory section he may access on a read/write basis.

With respect to claim 7, this dependent claim is rejected for the similar rationale given for claim 6.

With respect to claim 8, UStrim and Nielsen failed to teach, wherein the index code identifies the contents of the electronic record and the recipient of the electronic record. Mourier teaches, an index code identifying the contents of the electronic record and the recipient of the electronic record (page 7, lines 1-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the index code identify the contents of the electronic record and to modify in UStrim because such a modification would allow UStrim to have a command that sorts (index) the files by updated dates (index code).

With respect to claim 9, UStrim failed to teach, wherein the index code identified the contents of the electronic record and the recipient of the electronic record. Nielsen

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teaches, wherein the index code identified the contents of the electronic record and the recipient of the electronic record (col. Col. 1, lines 7-41). The nature of E-mail does not entitle any patentable weight and is considered a design choice.

With respect to claim 10, UStrim and Nielsen failed to teach, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record. Mourier teaches, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record (Page 8, lines 9-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to read a stored electronic tag and generating an electronic tag in response to accessing an electronic record and to modify in UStrim because such a modification would allow UStrim to have a subject and to have a message with the sender code and a recipient code.

With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 13, UStrim and Nielsen failed to teach, a computer system comprising at least one processor and at least one memory. Mourier teaches, a computer system comprising at least one processor and at least one memory (page 3, lines 1-18 and lines 46-49). This independent claim is rejected for the similar rationale as given above for claim 1.

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With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale as given above for claim 4.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

With respect to claim 23, this independent claim is rejected for the similar rationale as given above for claims 1, 13, and 17.

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Keller et al (US 5,906,656) disclosed electronic distributions (electronic mail).

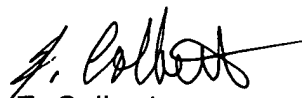
Landfield et al (US 5,632,011) disclosed electronic mail management.

Inquiries

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


E. Colbert
November 26, 2004